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09/407,915	09/29/1999	MATTHEW B. SQUIRE	2204/191	3365

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EXAMINER

MIRZA, ADNAN M

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW B. SQUIRE, KEDARNATH PODURI, and
HALDON J. SANDICK

Appeal 2007-4295
Application 09/407,915¹
Technology Center 2100

Decided: May 9, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP,
and JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 70. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Filed on Sep. 29, 1999. The real party in interest is Nortel Networks, Ltd.

The Invention

As depicted in Figure 1, Appellants invented a method and system for automatically configuring a data router (10) for connection to another router (131) in a communications network subnet. (Spec. 5.)

Claim 1 further illustrates the invention. It reads as follows:

1. A method of configuring a first network device for connection to a communications network subnet having a second network device, the method comprising:

determining, with a configuration determination module of the first network device, configuration attributes for operably connecting the first network device to the subnet based on configuration information for the subnet detected by the first network device; and

configuring the first network device, with an autoconfiguration module of the first network device, according to the configuration attributes so that the first network device is operably connected to the subnet.

Among the rejections of the claims on appeal, the Examiner rejected claims 7 through 14, 21 through 28, 35 through 42, 49 through 56, and 63 through 70 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hansen, Li and Reichmeyer.

PRINCIPLES OF LAW

PRIOR ART DISQUALIFICATION UNDER 35 U.S.C. § 103(c)

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c)(1)

ANALYSIS

Appellants argue that Reichmeyer is disqualified as prior art against claims 7 through 14, 21 through 28, 35 through 42, 49 through 56, and 63 through 70 under 35 U.S.C. § 103(c). Appellants submit that, at the time of the invention, the present application and Reichmeyer were commonly owned or assigned to the same entity. Appellants further submit that the present application is a continued prosecution application, filed January 2, 2003. Therefore, it qualifies for the benefits of the cited section. (App. Br. 11.) Appellants assert that the Examiner has failed to address this argument. (Reply Br. 7.)

Our review of the record before us reveals that Appellants filed a statement of common ownership with the Appeal Brief on January 30, 2004. The record further reveals that the Examiner did not deny entry of this after final request. Further, the Examiner has not otherwise dealt with this issue in the Examiner's Answer or in the response to Appellants' Reply Brief. Additionally, we note that while the Examiner's Answer discusses claim 29, it fails to include the claim as part of the statement of the rejection. (Ans. 6-7.) In light of the aforementioned deficiencies, this case is not ripe for a

meaningful review. *See* MPEP § 706.02.(I) (1). (8th ed., Rev. 6, Sep. 2007).

ORDER

Accordingly, we REMAND this application to the Examiner to:

- (1) respond to Appellants' arguments that Reichmeyer is disqualified as prior art under 35 U.S.C. § 103(c),
- (2) include claim 29 as part of the statement of the rejection, and
- (3) for such further actions in accordance with 37 C.F.R. § 41.43, as may be appropriate.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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